REMARKS

This Response ("Response") is in response to the September 7, 2006 Office Action ("Office Action"). Claims 1-33, 39-57, 63-65, and 68-90 are pending; claims 39-57, 63-65 and 75-78 are withdrawn from consideration.

CLAIM REJECTIONS

Claims 1-33, 68-74, and 79-90 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Sakaki (JP 8-294397) and Mitani (JP 8-59686). Claims 1-33, 68-74, and 79-90, stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Applicants respectfully assert that the none of the claims are anticipated, that all of the claims comply with 35 U.S.C. § 112, paragraphs, and all of the claims are allowable.

The Claims are Definite

Claims 1-33, 68-74 and 79-90 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Specifically, the Office action states that one would not know the metes and bounds of claim 1 where the R groups "are each independently a protecting group that is removable by an enzyme wherein the enzyme is an esterase or phosphatase," and that claim 33 does not define the enzyme. Applicants respectfully asset that the claims are definite.

First, the test for indefiniteness is whether the claim meets the threshold requirements of clarity and precision. MPEP 2173.02 states that "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." A protecting group that is removable by an esterase or phosphatase would be understood by one skilled in the art. Protecting groups are well known to one skilled in the art. The specification, for example, cites at page 17, lines 11-12, the book "Protective Groups in Organic

Synthesis." Eds. Greene, Wuts; John Wiley and Sons, New York, 1991. Both esterase and phosphatase are well known to one skilled in the art. As defined in Dorlands Medical Dictionary, esterase is "a term used in the recommended and trivial names of the hydrolases that act on ester bonds [EC3.1] to produce an alcohol and acid." As defined in Dorlands Medical Dictionary, a phosphatase is "a term used in the recommended names of some enzymes of the hydrolase class that are phosphoric monoester hydrolases [EC 3.1.3], catalyzing the release of inorganic phosphate from phosphoric esters." Given the teachings of the present application, the fact that the terms "protecting group," "esterase," and "phosphatase" are well known to one skilled in the art, the recitation that the protecting group R must be removable by an esterase or phosphatase clearly and precisely defines which R groups are within the scope of the claim.

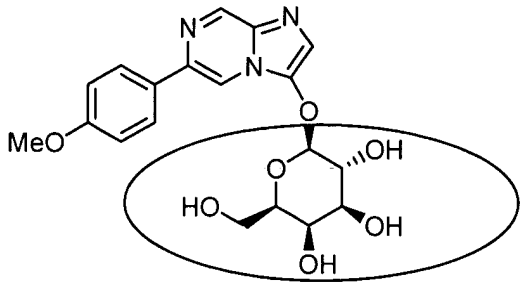
Second, claims 3-5, 8, 9, 14, 15, 18, 19, 68-74, 83-88 and 90 further modify the R^{11}, R^{14}, R^{15} and R^{16} groups with chemical structure. Even if the Examiner's position is that the one would not know the metes and bounds of a protecting group R that is removable by an esterase or phosphatase, the additional limitations for R in these claims sets the boundaries in terms of structure. As such, the applicability of this rejection to these claims has not yet been provided. Applicants respectfully request that the rejection be withdrawn.

Third, claims 84-90 do not recite the aforementioned terminology. As such, the basis for the rejection against these claims has not been set forth. Applicants respectfully request that the rejection be withdrawn unless and until the basis is set forth.

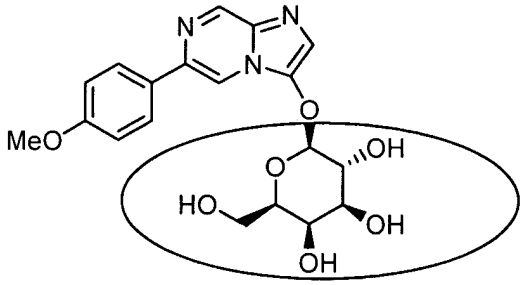
The Claims are Not Anticipated
Sakaki (JP 8-294397) and Mitani (JP 8-59686)

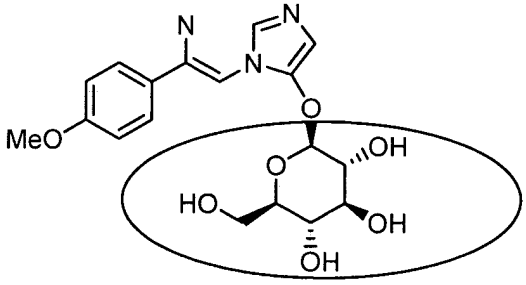
Claims 1-33, 68-74 and 79-90 stand rejected under 35 U.S.C. § 102(b) over each of Sakaki (JP 8-294397) and Mitani (JP 8-59686). Specifically, the Office action contends that the structure in the English abstract is encompassed by claim 1. Applicants respectfully disagree.

The compound in the abstract of Sakaki includes an organic side chain (circled below) in a position corresponding to the R^{11} group of claim 1:



Similarly, the compounds in the abstract of Mitani include the following organic side chains (circled) at positions corresponding to the R^{11} group of claim 1:





In contrast, claim 1 requires a corresponding R^{11} group, which is a protecting group removable by an esterase or phosphatase. Applicants respectfully request that the Examiner provide any reasoning or evidence in support of the the Examiners position that the organic side chains of of Sakaki or Mitani would constitute an R^{11} group as claimed. Absent such reasoning or evidence of record, , Applicants believe the rejection is improper and should be withdrawn.

Furthermore, in claims 3-5, 8, 9, 14, 15, 18, 19, 83-88, and 90, R^{11} is defined by chemical structure such as acetyl, butyryl, t-butyryl, acetoxymethyl, propanoyloxymethyl, butyryloxymethyl, pivaloyloxymethyl, or where $-OR^{11}$ is an ester. Each of these structures is different than anything provided for by Sakaki or Mitani.

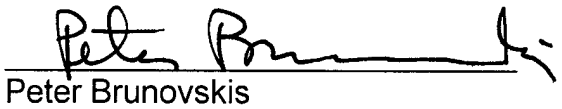
As the Sakaki and Mitani compounds are different from the compounds of the present application for at least the reasons presented herein, the Sakaki and Mitani

references do not anticipate claims 1-33, 68-74 and 79-90. Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

Applicants believe that currently pending Claims 1-33, 68-74, and 79-90 are patentable. Applicants respectfully request that the Examiner grant early allowance of this application. The Examiner is invited to contact the undersigned agent for the applicants via telephone if such communication would expedite this application.

Respectfully submitted,



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